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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/818,534	03/14/97	NELSON	W 3922

HM22/0320

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EXAMINER

HINES, J

ART UNIT	PAPER NUMBER
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1641

17

DATE MAILED:

03/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/818,534

Applicant(s)
Nelson et al.

Examiner
Ja-Na Hin s

Group Art Unit
1641



☒ Responsive to communication(s) filed on Nov 24, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 2 and 9-12 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2 and 9-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on August 25, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/818,534 is acceptable and a CPA has been established. An action on the CPA follows.

2. The amendment filed on August 25, 1999 under 37 CFR 1.312 has been entered. Claims 2 and 9-12 are pending in this office action.

Drawings

3. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Response to Arguments

4. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is withdrawn in view of applicants amendments.

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5. Applicant's arguments filed August 25, 1999 have been fully considered but they are not persuasive. Claims 2, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al. (US 4,487,198) in view of Herron et al., is maintained.

Applicants argue that Herron et al., is directed to detecting bacteria using fluoroimmunoassay while Nelson et al., teaches the use of detection using Raman backscattered energy spectrum and there is no suggestion to combine the immobilization techniques using antibodies of Herron et al., with that of Nelson et al. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

No more than routine skill is required to substitute biospecific antibodies for the disclosed polylysine, because biospecific antibodies are conventionally used to immobilize bacteria analytes for assay. Further, only routine skill is involved in adjusting the amount of a component, such as the number of antibodies used, of a claimed process to suite a particular starting material in order to achieve the results taught in the prior art.

In this case, it would have been obvious at the time of applicants' invention to have used capture molecules like antibodies immobilized to a solid phase which specifically bind in antibody-antigen complex where the antigen or analyte is a microorganism as taught by Herron

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et al., in conjunction with a method for detecting the presence of a specific microorganism in a sample as taught by Nelson et al., because Herron et al., teaches immobilizing bacteria using antibodies is well known in the art as a method of immobilization.

6. Claims 2 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chadha et al., in view of Herron et al., is maintained.

In response to applicant's argument that Herron et al., is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. In this case, Herron et al., is not nonanalogous art because Herron et al., teaches methods for capturing molecules immobilized to the surface by site specific coupling. Herron et al., also teaches the immobilization of capture molecules on the surface and capture molecules are chosen because of their binding moiety, then the sample solution which contains the analyte molecule binds and a measurable amount of analyte can then be detected. Therefore, Herron is analogous art because it teaches methods of detection and method of immobilization.

No more than routine skill is required to substitute biospecific antibodies for the disclosed polylysine, because biospecific antibodies are conventionally used to immobilize bacteria analytes for assay. Further, changes in concentrations or the amount of antibody for a process known in the art does not impart patentability.

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, it would have been obvious to one skilled in the art to use antibody immobilization as taught by Herron et al., to modify the method and system of Chadha et al., because Herron et al., teaches substituting the immobilization of antibody to a solid phase because the specificity of antibodies are conventionally used to bind and immobilize bacterial antigens for an assay.

7. This is a Continuation of applicant's earlier Application No. 08/818,534. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MEP. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na Hines whose telephone number is (703) 305-0487. The examiner can normally be reached on Monday through Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Ja-Na Hines



March 15, 2000


CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800-1641